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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,857	12/11/2003	Michael Patane	CASM122094	8103
26389	7590	08/18/2004	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			FORD, ALLISON M	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/733,857	PATANE, MICHAEL	
	Examiner	Art Unit	
	Allison M Ford	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a process for purifying a phosphodiesterase 1, classified in class 435, subclass 187.
- II. Claim 17, drawn to a phosphodiesterase (PDE-1), classified in class 435, subclass 199.
- III. Claim 18, drawn to a cell including a phosphodiesterase (PDE-1), classified in class 435, subclass 410.
- IV. Claim 19, drawn to a process for producing a ribonucleotide, classified in class 435, subclass 68.1.
- V. Claim 20, drawn to a ribonucleotide, classified in class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the phosphodiesterase of Invention II can be synthesized, it is not required to be extracted from a cell in the process of Invention I.

Inventions I and III are independent inventions and thus are subject to restriction. The inventions are patentably independent because the inventions are not dependent on each other, are capable of use independently, and they have different functions, modes of operation, and effects. In the instant case the method of Invention I does not require the cell of Invention III. The method of Invention I can be practiced on any source, including any cell, that contains PDE-1, it does not require the specific cell source of Invention III. Further, the cell of Invention III can be used in processes other than the method of Invention I, such as the production of various proteins for experimental purposes.

Inventions I and IV are independent inventions and thus are subject to restriction. The inventions are independent processes in that the methods are not dependent on each other, not to be used together and have different functions, modes of operation, and effects. In the instant case the method of Invention I requires heating an extract of a cell to produce a phosphodiesterase, which is not required by the method of Invention IV. Further, the method of Invention IV requires the use of a ribonucleotide, which is not required by Invention I.

Invention I and Invention V are independent inventions and thus are subject to restriction. The inventions are independent in that they are not required, one for another, are not capable of use together, and have different functions, modes of operation, and effects. In the instant case the ribonucleotide of Invention V is not required by, or produced by the method of Invention I.

Inventions II and III are independent inventions and thus are subject to restriction. The inventions are patentably independent products that are not dependent on each other, capable of use independently, and they have different functions, modes of operation, and effects. In the instant case, though the cell of Invention III contains the phosphodiesterase of Invention II, the

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cell of Invention III is independent because it is usable for processes that do not depend on the phosphodiesterase, such as the production of other enzymes or proteins for study. Further, the phosphodiesterase of Invention II can be obtained from sources other than the cell of Invention III, the phosphodiesterase can be obtained from any number of cells, or synthesized.

Additionally, the phosphodiesterase is intended for use in enzymatic processes that do not require the cell of Invention III.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case a ribonucleotide can be extracted from a cell or synthesized.

Inventions II and V are independent and thus subject to restriction. The inventions are independent products that are not dependent on each other, capable of use independently, and they have different functions, modes of operation, and effects. In the instant case, the ribonucleotide of Invention V can be used to produce recombinant cells. The phosphodiesterase of Invention II can be used to hydrolyze cyclic AMP molecules.

Invention III is independent from Inventions IV and V, thus they are subject to restriction. The cell of Invention III is not required by, or produced by the method of Invention IV. Further, the cell of Invention III does not contain or produce the ribonucleotide of Invention V, nor are they usable together.

Inventions IV and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be

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used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the ribonucleotide of Invention V can be synthesized or produced by a recombinant cell.

Therefore, a search and examination of all inventions in one patent application would result in an undue burden. These inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, different classifications, and a search for one group does not require a search for another group, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Lee Johnson on 8/13/04 a request was made to receive the restriction requirement by mail. An election must be made by applicant in replying to this Office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allison M Ford whose telephone number is 571-272-2936. The examiner can normally be reached on M-F 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0927. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Allison M Ford  
Examiner  
Art Unit 1651

AMF

  
LEON B. LANKFORD, JR.  
PRIMARY EXAMINER